

REMARKS

Office action summary

Claims 1-9, 11-14, and 18-41 are pending in the present application. Claims 1, 18, and 22 are independent claims. Claims 1, 18, and 22 are presently amended. Claim 42 is presently added. No claims are presently cancelled. The following rejections were made in the office action of January 27, 2009 (“Office Action”):

- Claims 18-20 were rejected under 35 USC § 103(a) as being unpatentable over Dimitri et al, US Patent 6,574,424 (“Dimitri”).
- Claim 21 was rejected under 35 USC § 103(a) as being unpatentable over Dimitri in view of Lowthert et al, US Publication 2002/0100043 (“Lowthert”).
- Claims 1, 5-9, 11, 22-27, 30-31, 34-35, and 38 were rejected under 35 USC § 103(a) as being unpatentable over Lowthert in view of Getsin et al, US Patent 7,269,634 (“Getsin”), and further in view of Sartain et al, US Patent 5,914,712 (“Sartain”).
- Claims 12-13 were rejected under 35 USC § 103(a) as being unpatentable over Lowthert in view of Getsin and Sartain, and further in view of Sandstrom, US Patent 6,238,763 (“Sandstrom”).
- Claims 2-4, 14, and 36-37 were rejected under 35 USC § 103(a) as being unpatentable over Lowthert in view of Getsin and Sartain, and further in view of Shear et al, US Publication 2001/0042043 (“Shear”).
- Claims 28-29 were rejected under 35 USC § 103(a) as being unpatentable over Lowthert in view of Getsin and Sartain, and further in view of Ginter et al, US Publication 2004/0054630 (“Ginter”).
- Claims 32-33 were rejected under 35 USC § 103(a) as being unpatentable over Lowthert in view of Getsin and Sartain, and further in view of Russo, US Patent 6,732,366 (“Russo”).

The rejections are discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections. Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants’ undersigned attorney, Jon M. Isaacson, at 206-332-1102.

Telephonic interview

On March 31, 2009, applicants' undersigned attorney and Examiner Shang conducted a telephonic interview. Applicants' undersigned attorney would like to thank the examiner for granting the interview. During the interview, the independent claims were discussed with reference to the cited art of record. No agreements were reached. Any further substance of the interview is incorporated into the remarks below.

Rejections under 35 USC § 103(a)

Claim 18

Claim 18 stands rejected under 35 USC § 103(a) as being unpatentable over Dimitri. Claim 18 recites “a reader mechanism having a single optical pickup and configured to read entertainment content pre-recorded on a first medium and to read advertisements pre-recorded on a second medium, *wherein said first medium is physically distinct from said second medium.*” (Emphasis added.) Applicants submit that Dimitri fails to teach or suggest a reader mechanism configured to read entertainment content and advertisement content pre-recorded on physically distinct media.

In the Office Action, the examiner concedes that Dimitri is silent as to a first medium being physically distinct from a second medium. (Office Action, page 8.) However the examiner then cites to portions of Dimitri which disclose various DVD implementations, including dual-sided DVDs, dual-layer DVDs, and a single-layer DVD which is partitioned into sectors. (Office Action, page 8; citing to Dimitri, figs. 1-5, and col. 3 line 43 – col. 4 line 65.) The examiner especially relies on the partitioned DVD as showing entertainment content in one sector and advertisement content in another sector. (Office Action, page 8.) The examiner asserts that these sectors are physically distinct from one another. (*Id.*) In other portions of Dimitri, the partitioned DVD is described as containing “[c]ommercials, cartoons, movie trailers or other short video clips are stored *on the same DVD disk* that holds a DVD movie.” (Dimitri, col. 6, ll. 7-9; emphasis added.) Further, Dimitri describes that “[a] vector of video clips are stored *on the DVD disk [for playing]* video clips” where the video clips include “cartoons, commercials, movie previews, etc.” (Dimitri, col. 2, ll. 13-20.)

Applicants respectfully submit that the examiner has failed to make a *prima facie* case of obviousness because the cited portions of the cited art fail to teach or suggest “wherein said first medium is physically distinct from said second medium,” as recited by claim 1. Applicants respectfully disagree with the examiner’s interpretation of physically distinct media. According to the examiner’s argument, two sectors of information located on a single DVD are physically distinct from each other because each sector is continuous on the DVD and stores data associated with a single video segment. Applicants submit that the two sectors of Dimitri’s DVD are located on the same physical medium, namely the DVD. The sectors cannot be separated from each other without destroying the DVD in some way. Even though the sectors may be located on different locations on the DVD, they are still located on the same DVD. In contrast, claim 1 recites that “said first *medium* is physically distinct from said second *medium*.[”]

Without conceding this point, applicants presently amend claim 18 to recite that the second medium is recorded after the first medium is received at the play device. Applicants submit that this recitation makes it impossible for the first and second medium to be contained on a single optical disk, as shown by Dimitri. Further, because of the temporal nature of the recitation, it would not be obvious to one of skill in the art to simply physically separate the sectors shown on Dimitri’s optical disk and arrive at two separate media.

For at least these reasons, applicants submit that claim 18 is patentably defined over the cited art. Accordingly, applicants request withdrawal of the rejection of claim 18 under 35 USC § 103(a).

Claims 1 and 22

Claims 1 stands rejected under 35 USC § 103(a) as being unpatentable over Lowthert in view of Getsin and further in view of Sartain. Claims 1 and 22 contain similar recitations which applicants submit are not taught or suggested by the art cited in the references. For example, claim 22 recites, in part:

distributing to each customer...at least one advertisement medium containing a plurality of prerecorded advertisements...;

updating at least some of the advertisements on said advertisement medium with respect to previously distributed advertisements; and

periodically distributing to each of said customers said updated advertisements pre-recorded on an updated advertisement medium;

whereby said consumer is capable of viewing said entertainment content together with said updated advertisements, wherein said updated advertisements were not available at the time that the entertainment content was distributed.

Thus, as recited, after advertisements have been distributed to a customer on a pre-recorded medium, the advertisements are updated, and the updated advertisements are periodically distributed on pre-recorded updated advertisement media. Applicants submit that claims 1 and 22 are patentably defined over the cited art for at least the following two reasons:

First, in the Office Action, the examiner cites to Lowthert as teaching, at Fig. 1 and paragraph 0024, distributing “ads and other content upon request using a sneakernet via conventional mail.” (Office Action, page 6.) The examiner then states, “[a]lthough one skill [sic] in the art knows that these distribution methods, e.g., conventional mail, etc., is usually done periodically (monthly), Lowthert is silent as to updating at least some of the ads with respect to previously distributed ads.” (Office Action, page 6.) Applicants respectfully submit that the examiner’s reasoning is in error with respect to applicants’ claims. The question is not whether one of ordinary skill in the art would understand that conventional mail is done periodically, but whether one of ordinary skill in the art would find it obvious, in light of the cited art, to periodically distribute pre-recorded updated advertisement media.

While the examiner indicates that Lowthert is silent as to updating advertisements with respect to previously-distributed ads, the examiner then cites to Getsin as teaching a “method for remote control and navigation of local content where and further discloses updating some of the local content accordingly.” (Office Action, page 6.) The cited portions of Getsin describe a “method for synchronizing an event on a plurality of client apparatuses.” (Getsin, col. 12, ll. 6-7; see also col. 12 line 5 – col. 13 line 3.) Specifically, Getsin describes providing the clients with content via DVD, WEBTV, or streaming video over the internet. (Getsin, col. 12, ll. 6-44.) Then, a host computer communicates with the client apparatuses over a computer network to control the simultaneous playback of the content at the client locations. (Getsin, col. 12, line 45 – col. 13, line 3.) Applicants fail to discern how Getsin, when read in light of Lowthert, teaches or suggests updating advertisements with respect to previously-distributed advertisements. While Lowthert may disclose sending ads on discs via

conventional mail, and Getsin may disclose sending content to multiple users for synchronous playback, applicants submit that the cited portions of Lowthert and the cited portions of Getsin, individually or in combination, fail to teach or suggest updating advertisements with respect to previously-distributed advertisements before the updated advertisements are distributed to customers on a pre-recorded medium. Further, applicants submit that Sartain fails to cure these deficiencies in Lowthert in view of Getsin, and Sartain is not cited by the examiner for that purpose.

Second, in the Office Action, the examiner indicates that Lowthert in view of Getsin are silent as to periodic distribution of updated ads to various clients. (Office Action, page 7.) reads Sartain discloses “an interactive video system which periodically (once a day, once a week, etc.,) distributes ads and other content via overnight mail to remote sights.” (Office Action, page 7.) The relevant portion of the Examiner’s citation to Sartain states:

Satellite 300 can also be used to transmit video programs from office 330 to earth headends 370 and 372.... When a satellite is not utilized to distribute the video programming, a variety of other techniques can be used. When a satellite is not utilized...*the video programs* can be sent, in the preferred embodiment, via overnight mail to earth headends 110, 112, 114, 370, and 372. In addition, *the video programs* can be sent via any available transmission line means (e.g., telephone line, coax cable, fiber optic cable, and the like). In the preferred embodiment, *selectable video programs* are updated once a day to once a week. A satellite allows downlink on command such that desirable videos and commercials can be quickly inserted into a queue at the remote site.

(Sartain, col. 8, ll. 29-43.) As shown, Sartain indicates that *video programs* can be sent via overnight mail and that *selectable video programs* can be updated once a day or once a week. Thus, Sartain is using overnight mail as a means of distributing video programs to customers where a satellite broadcast is unavailable. However, the cited portions of Sartain, when read in light of Lowthert and Getsin, fail to teach or suggest periodically distributing updated advertisements pre-recorded on a medium as recited by claims 1 and 22.

Without conceding that the examiner’s rejection, applicants presently amend claims 1 and 22 to recite that the method allows the consumer to view the entertainment content together with updated advertisements that were not available at the time the entertainment content was distributed. While Lowthert, Getsin, and Sartain may describe updating content

DOCKET NO.: **OO-0071
Application No.: 10/072,471
Office Action Dated: January 27, 2009

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provided to a user, applicants are unable to discern any teaching or suggestion that updated advertisements are provided to a user to be displayed together with entertainment content distributed before the updated advertisements were available.

For at least the reasons cited above, applicants submit that claim 1 and 22 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claims 1 and 22 under 35 USC § 103(a).

Claims 2-9, 11-14, 19-21, and 23-41

Claims 2-9, 11-14, 19-21, and 23-42 depend, directly or indirectly, from claims 1, 18, and 22. Inasmuch as claims 1, 18, and 22 depend from independent claims which are patentably defined over the cited art, applicants submit that claims 2-9, 11-14, 19-21, and 23-41 are patentably defined over the cited art. Accordingly, applicants respectfully request withdrawal of the rejection of claims 2-9, 11-14, 19-21, and 23-41 under 35 USC § 103(a).

Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the Office Action, and submit that claims 1-9, 11-14, and 18-42 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

Date: April 27, 2009

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